REMARKS

Applicant has carefully reviewed and considered the Examiner's Action mailed August 21, 2006 (an Advisory Action). This Amendment accompanies a Request for Continued Examination (RCE) and reconsideration is respectfully requested in view of the foregoing amendment and comments set forth below.

By this Amendment, claims 1, 3-4 and 12 are amended, and claim 2 is canceled. Accordingly, claims 1 and 3-12 are pending in the present application.

35 U.S.C. §112, first paragraph

Claims 1 and 12 were rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description. In particular, the June 6th, 2006 Office Action states the claims recite new subject matter that was not in the original claim language and the Examiner cannot find the new claim language within the specification. In response to Applicant's argument that, the description from page 12, line 16 to page 13, line 2 and Figure 2 of the present specification provides support for the claimed subject matter, the Examiner asserts that "Applicant is required to provide a clear and concise disclosure for each claim limitation." As best understood by Applicant, it is the Examiner's position that the exact claim language must appear in the originally-filed specification.

MPEP 2163.06 states that "information contained in any one of the specification, claims or drawings of the application as filed may be added to any other part of the application without adding new matter." In particular, the mere rephrasing of a passage does not constitute new matter where the same meaning remains intact. MPEP 2163.06

Figure 2 of the present specification shows information elements (e.g., IT1 to 3) of a unit data (e.g., mail magazine shown in Figure 2) divided or partitioned by, for

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example, em dots DL. The information elements have structure information (e.g., LD 1 to LD3; AB1 to AB3 and UR1 to UR3), as shown in Figure 2 of the application as filed. Claims 1 and 12 are amended to more closely rephrase page 12, line 16 through page 13, line 2 as follows:

> a division processing section to divide said unit data into the plurality of information elements based on <u>the predetermined divisions where the plurality of information elements have an information structure that can be viewed by a user to detect information of information elements consistent with a predetermined division</u>

The rephrasing of the terms: "articles" (information elements); "patterns" (predetermined divisions); "typical structure" (information structure); and "sections" (information) does not change the meaning of the originally filed specification, but uses claim terminology. Accordingly, it is respectfully submitted that the recited features of claims 1 and 12 fully comply with the written description requirement of 35 U.S.C. §112, first paragraph.

35 U.S.C. § 102(e) Rejection based on Carley

Claims 1, 2, and 4-12 were rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Carley (U.S. Patent No. US 6,701,345 B1). Applicant respectfully traverses this rejection.

Independent claims 1 and 12 recite, respectively, an information processing system and method for processing unit data including a plurality of information elements (e.g., articles of a e-mailed newspaper) partitioned at predetermined divisions (e.g., patterns). The system and method each recite a division processing section, an extraction processing section; a condition determination section, and a notification section. The division processing section divides "the unit data into the plurality of information elements based on the predetermined divisions where the plurality of information

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elements have an information structure that can be viewed by a user to detect information of information elements consistent with a predetermined division" (claims 1 and 12). The extraction processing section allocates a logical structure (e.g., a hierarchical structure or tree structure) to each of the information elements. The condition determination section is supplied with a select condition, and selects the information element conformable to the select condition from among the plurality of information elements obtained by dividing the unit data. The notification section notifies a user of the information element selected by the condition determination section.

In the present invention, the divisions of information elements are decided based on predetermined divisions that are detected within the unit data and the information elements have an information structure if viewed by a user to detect sections or information consistent with a predetermined division or pattern. The present specification describes this division, for example, from page 12, line 16, to page 13, line 2. Each information element is divided with separators, and the separators are used when displaying e-mail on a display, as shown in Figure 2.

In contrast, Carley describes providing a notification when a plurality of users are altering similar data in a health care solution environment. Column 13, lines 35-40 simply describe a plurality of records/files and a command to load the records into a database where the command may be executed automatically at predetermined intervals. This disclosure fails to meet the recited features of processing a unit data including a plurality of information elements partitioned at predetermined division as set forth in the "division processing section" of claim 1 or the "allowing a division processing section to divide" of claim 12.

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The Office relies on diagram 506 in Figure 5, column 81, lines 20-21, and column 14, lines 35-52 of Carley for satisfying the claimed division processing section. It is the Action's position that the building of bridges in column 81 of Carley is a "structural pattern". But, claims 1 and 12 recite a division processing section to divide said unit data into the plurality of information elements based on <u>the predetermined divisions where the plurality of information elements have an information structure that can be viewed by a user to detect information of information elements consistent with a predetermined division.</u> There is no disclosure in Carley how these bridges may be an information structure that can be viewed by a user to detect information consistent with a predetermined division, as set forth in claims 1 and 12.

In one embodiment, Carley determines whether a certain description is the description on a medical record (matches the predetermined criteria) and data that does not match the predetermined criteria is compiled. Thus, Carley simply divides records that do match a certain criteria. This is not the claimed invention where the articles are separated by separators and the information of the articles are divided by order of appearance in a predetermined division as set forth in the extraction processing section of claims 1 and 12. Applicant respectfully submits that Carley nowhere describes or reasonably suggests dividing the data based on predetermined divisions or the extraction processing section, as required by independent claims 1 and 12 and supported by Figure 2 of the application. In order to anticipate the claims, Carley must disclose each and every feature recited therein. As argued above, Carley fails to disclose at least the recited "division processing section" of claim 1 and the "allowing a division processing section to divide" of claim 12. Consequently, Carley cannot anticipate claim 1 or claim 12 under

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35 U.S.C. § 102(e) because there must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention.

Claims 2 and 4-11 are allowable as being dependent from an allowable claim.

Applicant respectfully requests reconsideration and withdrawal of the rejection of Claims 1, 2 and 4-12 under 35 U.S.C. § 102(e) as being anticipated by Carley.

35 U.S.C. § 103(a) Rejection based on Carley and Conklin

Claim 3 was rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Carley in view of Conklin (U.S. Patent No. US 6,338,050 B1). Applicant respectfully traverses this rejection.

Claim 3 depends from claim 1 and is allowable as being dependent from an allowable claim.

Further, Conklin describes a system and method for providing and updating user supplied context for a negotiations system. Conklin fails to supplement the deficiencies of Carley because Conklin fails to teach or reasonably suggest dividing data based on predetermined divisions where the information elements have an information structure consistent with a predetermined division and a logical structure to divide information within the information elements. Applicant respectfully requests reconsideration and withdrawal of the rejection of claim 3 under 35 U.S.C. § 103(a) as being unpatentable over Carley in view of Conklin.

Information Disclosure Statement

The Information Disclosure Statement (IDS) filed June 24, 2003 is objected to because it allegedly fails to comply with 37 C.F.R. § 1.98(a)(2). It is unclear to

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Applicant why the Examiner maintains the position that a translation is required. While the rule requires "A legible copy of the foreign patent", the MPEP and 37 C.F.R. § 1.98(a)(2) do not require a TRANSLATION of each cited foreign patent document. To the contrary, only a concise explanation of the relevance, which may be either separate from applicant's specification or incorporated therein is required by 37 C.F.R. § 1.98(a)(3)(i). An English-language translation is requested, if it is **readily available**. The English-language document that was and is available is the abstract from Patent Abstracts of Japan that was supplied to the U.S. Patent Office with the IDS on June 24, 2003. There is no requirement of a translation of a foreign patent and the English-language document is a sufficient statement of relevance. Thus, the Examiner should consider the patent to the extent possible by the English-language Abstract and any drawings. The Examiner has not quoted a rule in 37 CFR 1.98, but created a new interpretation for legible. The Examiner is asked to reconsider this position which is not supported by the MPEP or 37 CFR 1.98 and consider Japan '189 to the extent possible. Applicant has attached another PTO/SB/08A form listing Japan '189 and the English abstract in the category requested by the Examiner. The Examiner is respectfully requested to consider Japan '189 and return an initialed copy of the attached PTO/SB/08A form.

Conclusion

In view of the foregoing comments, it is believed that claims 1 and 3-12 are allowable over the prior art of record. Accordingly, it is respectfully requested that a Notice of Allowance be issued indicating that claims 1-12 are allowed over the prior art of record.

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Should the Examiner believe that a conference would advance the prosecution of this application, the Examiner is encouraged to telephone the undersigned counsel to arrange such a conference.

Respectfully submitted,

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